IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Andrew D. Simchik et al. Art Unit: 2622

Application No.: 09/496,698 Examiner: Joseph R. Pokrzywa

Filed: February 2, 2000 Docket No.: 99486-US-CiP
XERZ 2 00531-3

For: DOCUMENT PRODUCTION SYSTEM FOR CAPTURING WEB PAGE CONTENT

MAIL STOP Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

Applicant transmits herewith three (3) originally signed copies of BRIEF ON APPEAL for the above-reference patent application.

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Respectfully submitted,

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4/3/06

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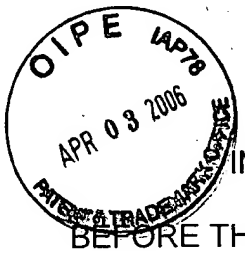
PATENT APPLICATION



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BRIEF ON APPEAL

Appeal from Group 2622

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TABLE OF CONTENTS

I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Xerox Corporation by way of an Assignment recorded in the U.S. Patent and Trademark Office on February 2, 2000, Reel 010601, Frame 0596 (2 pages).

II. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 8-13 and 27-31, which are all claims remaining in the application.

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed in response to the Office Action of June 24, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The concepts of claim 8 are directed to: a method for converting a page from a network into an image file suitable for assembly or insertion into a document generated by a document creation algorithm. The steps of this claim include, inserting a link into a document corresponding to content present in the network, launching a browser in response to the link, retrieving the content from the network (such as the Internet), automatically converting the content into an image file suitable for insertion into the document (*see* page 7, lines 11-36), and inserting the converted content into the document (*see*, page 8, lines 1-6).

Claim 9 permits for a step of inserting a link which includes inserting a URL into the document, and where a launching step includes launching a web browser.

Claim 10 recites that the step of inserting, which includes directly inserting the converted content into the document (*see,* page 8, lines 1-6), where the image file being imported into the document is directly imported into a document creation algorithm (*see,* page 5, line 35 to page 6, line 9).

Claim 11 further includes inserting the link into the document, to dynamically retrieve the content associated with the web page (*see*, page 8, lines 24-32).

Claim 12 calls for repeating the steps defined in the independent claim 8.

Claim 27 further defines that the content of the web pages inserted into the document such that when the document is printed in a hard-copy format, the content of the page is printed into the hard-copy format as part of the document (*see*, page 9, line 35 through page 10, line 7).

Independent claim 28 is to a printing system (*e.g.*, element 10) which dynamically links content from an existing network page (*e.g.*, a web page) into a document generated by a document creation algorithm (*see*, element 20 – which may be Adobe Acrobat, Xerox DigiPath, *etc.)* . This system includes a document creation algorithm to create, retrieve or assemble a document, a link facility for manually creating and inserting a link network (*e.g.*, link facility 22) into the document, wherein the link is associated with an existing network page, a browser (*e.g.*, 24) for automatically accessing and retrieving the content of the network page with the link, and a production agent (*e.g.*, 26) to automatically convert the content of the web page into an image file for automatically inserting the content into the document.

Claim 29 (intended to depend from claim 28) recites that upon subsequent access of the document, a browser would retrieve the most recently updated content of the network page without need for action or knowledge of a user.

Claim 30 defines that upon subsequent access the production agent will automatically convert the content of the network page into an image file and insert the content into the network page, again, without action or knowledge of the user.

Claim 31 notes that the inserted content of the network page is readily available in a readable forward for display on a user interface or for printing.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review: Claims 8-12 and 27-31 are rejected as anticipated under 35 U.S.C. §102(b) by Brobst *et al.* (U.S. Patent Number 6,061,700).

VII. ARGUMENT

To anticipate a claim, the 35 U.S.C. § 102 reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131.

Independent claims 8 and 28 of the subject application recite a method and system respectively for automatically generating and linking content from existing network pages, using a method and system which creates, retrieves and assembles the document; a link facility for manually creating and inserting a network link associated with existing network pages; a browser which automatically retrieves the content of those pages; and a system for automatically converting the content into a printer friendly image thereby creating a single document.

In addition dependent claims 9-12, 27 and 29-31 further define the inventive concepts. In particular, claims 29 and 30 recite a system where subsequent access of the document being printed automatically retrieves the most recently updated content from the network and then converts that content into a printer friendly image file for insertion into the printed document without any action from the user.

By way of review, Brobst et al. '700 is an apparatus and method for formatting a specified group of related web pages into a single web page. The user will define a number of selected pages and associated relation criteria for each selected page. The formatting mechanism will collect the URLs for the selected pages, and store the URLs into a URL container. The formatting mechanism will further invoke each web page associated to the URLs contained in the URL container and generate a conglomerate page. The conglomerate web page may include data inserted into or referenced in one or more of the selected pages. The conglomerate web page may then be printed using

a standard browser print function. Thus, Brobst et al. takes a variety of URLs and flattens them into a conglomerate page.

Contrary to Brobst, the present application is directed to a method of converting pages from a network into an image file suitable printing to be assembled or inserted into a document generated by a document creation algorithm. The present system will therefore take a network page (*i.e.*, web page) and convert the content of the page. By this design, the user may create a document including content of a web page. In addition, as mentioned above, claims 29 and 30 claim a system which updates the content from the web page every time the document is accessed so that the most recent updates to the content (i.e., web pages) will be included in the final document.

A. Claims 8-12, 27-31are Not Anticipated By Brobst

1. Independent Claim 8

Initially, it is noted independent claim 1 includes in its preamble differentiation between "a page in a network" and "a document." Specifically the page the a network is directed to a web page, where a document is a type of document created by a document creation algorithm such as discussed on page 8, lines 1-22 of the description. Particularly, this language which is carried through in the body of the claim, differentiates between the accumulation of web pages as in Brobst et al. '700, which simply takes a variety of URLs and flattens them into a conglomerate page and a document. More particularly, in claim 8, it is clarified that the page from the network is a "web page", which is inserted into a document. This is quite different from Brobst et al. '700, which simply accumulates web pages into a single flattened web page.

Further, Applicants' claim 8 includes the following step: "automatically converting the content of the page into an image file suitable for insertion into the document." The 35 U.S.C. § 102 rejection is based on two locations in the '700 patent which it is alleged teaches the above claimed concepts. Brobst et al. '700 patent is column 6 lines 17-42 and column 7, line 10 to column 8, line 16.

The first location from the Brobst et al. '700 is column 6 lines 17-42. The reference refers to a "web page formatting mechanism", this mechanism does not convert the content of the web page (*e.g.*, an HTML file) into an image file as specified in the Applicants' claim 8. On the other hand, claim 8 specifies a method for

"automatically converting the content of the page into an image file suitable for insertion into the document." This conversion is not taught in column 6 lines 17-42 of the Brobst et al. '700 patent, rather Brobst et al. simply combines an HTML web page with existing web pages which are also in the HTML format. Brobst et al. does not anticipate the conversion of the web page.

The second cited location of Brobst et al. is column 7, line 10 to column 8, line 16. This section also does not address conversion of a web page. Instead this discussion deals with the prior art's "digging" element. Digging refers to the ability for the system to find the webpage selected by the user and then to dig and retrieve the web pages that are hyperlinked within the user specified web page. Furthermore, web pages that are "dug up" from the user specified web page can be analyzed for hyperlinks and these web pages can be retrieved. This would be an example of digging two levels down from the user specified web page. Applicants submit this discussion does not anticipate the concepts of claim 8, which require the conversion of a web page. Applicants' specification specifically states that "conversion" is the process of converting the page (*e.g.*, HTML) file into a printer friendly format (such as PDL) which is then converted, often by the printing device, into the image file for printing. See page 2, line 13-17 and page 7, lines 11-23. In no way does Applicants' element refer to the process of digging and collecting the underlying web pages which are hyperlinked within the user selected web pages.

Applicants submit that at least for these reasons Brobst et al. '700 does not anticipate all of the limitations in Applicants' claim 8, and request the 102 rejection be withdrawn and claim 8 and its dependent claims 9-12, and 27 be made ready for allowance.

2. Dependant Claim 10

Claim 10 specifically recites that the converted content is directly inserted into the document. The converted content is the content of the web page. On the other hand, Brobst et al. '700 is accumulating the URLs and, again, putting them into a single page. However, it is submitted this does not anticipate directly inserting the converted content into the document. Particularly, it cannot be seen from Brobst et al. '700 that there is converted content, or that the content is directly inserted into a document.

3. Dependant Claim 27

Applicants respectfully submit the concepts of claim 27 are also not anticipated by the cited art. Particularly, claim 27 recites that the content of the page is inserted into the document, whereby when the document is "printed into a hardcopy format, the content of the page is printed into the hardcopy format as part of the document." It is submitted the cited Brobst et al. '700 patent is simply designed to provide a flattened URL page, and not to provide the creation of a hardcopy document whose content will be printed in a hardcopy form.

4. Independent Claim 28

Claim 28 is rejected based on 35 U.S.C. § 102 for similar reasons as claim 8. Therefore, the preceding distinctions raised in connection with claim 8 are deemed to be relevant to the discussion of claim 28 and are therefore wholly incorporated herein.

Additionally, the final element of the system claimed in claim 28 is "a production agent for automatically converting the content of the network page into an image file and for automatically inserting the content into the document." The Brobst et al. '700 patent is again cited, and column 6 lines 17-42 and column 7 line 10 through column 8 line 16 are pointed to.

The first citation from Brobst et al. '700 is column 6 lines 17-42. Although the citation refers to a "web page formatting mechanism", this mechanism does not convert a network page into an image file as specified in the Applicants' claim 28. Applicants in claim 28 specify a printing system which includes, "a production agent for automatically converting the content of the network page into an image file and for automatically inserting the content into the document." This production agent used for conversion into a printable format of Applicants' claim 28 is not anticipated by column 6 lines 17-42 of the Brobst et al. '700. Rather Brobst et al. simply combines an HTML web page with an existing HTML web page. Brobst et al. does not teach the production agent for automatic conversion of the web page before inserting it into the compilation file which is printed.

The second citation is to column 7, line 10 to column 8, line 16. This discussion does not address conversion of the network page. Instead this section, again, deals with the prior art's "digging" element. As previously mentioned, digging refers to the

ability for the system to find the webpage selected by the user and then to dig and retrieve the web pages that are hyperlinked within the user specified web page. Furthermore, web pages that are "dug up" from the user specified web page can be analyzed for hyperlinks and these web pages can be retrieved. This would be an example of digging two levels down from the user specified web page. Applicants argue that this reference is improper to be cited against claim 28, which requires the use of a production agent for conversion of the network page. Applicants clearly state in their specification that the production agent is used for converting the HTML file into a printer friendly format such as PDL which is then converted, often by the printing device, into the image file for printing. See page 2, line 13-17 and page 7, lines 11-23. In no way does Applicants element refer to the process of digging and collecting the underlying web pages which are hyperlinked within the user selected web pages.

Applicants submit that because the Examiner's reference does not anticipate limitation of "a production agent for automatically converting the content of the network page into an image file and for automatically inserting the content into the document," that the all element rule of MPEP 2131 is not met and therefore the Brobst et al. '700 does not anticipate all of the elements in Applicants claim 28. Applicants therefore request that the 35 U.S.C. § 102 rejection be withdrawn and claim 28 and its dependent claims 29-31 be made ready for allowance.

5. Dependant Claims 29 and 30

Applicants agree with the Examiner's position that claim 29 should depend from claim 28, and the existing dependency from claim 27 is improper. This is a typographical error, and Applicants will request amendment of this claim upon receiving a decision regarding this appeal.

Claim 29 (which is intended to be dependent upon claim 28) teaches a system where "upon subsequent access of the document, the browser launches automatically accessing and retrieving the most recently updated content of the network page without need for action or knowledge by the user." This element is not anticipated by Brobst et al. '700. Although the '700 patent does retrieve web pages, no where is it taught that upon "subsequent access" that the system goes out and retrieves the most recent web pages. Instead, the '700 patent reference (column 6, line 54-colunm 7, line 19) teaches

the process of digging, creating a nesting structure, and retrieving the associated web pages only when the program is first run. The '700 patent does not anticipate an automatic update each time the document is accessed, instead it teaches the steps beginning with selecting the web pages or URLs to be included, then selecting digging level and then the automatic system begins processing. (column 6, lines 54-64). So, one cannot automatically retrieve the updated content by simply through "subsequent access of the document" where there is no "need for action or knowledge of a user," as stated in claims 29 and 30. The '700 patent teaches selection of both web pages and digging levels each time the document is to be updated, which requires the user to consciously interact with the system. These requirements do not ensure that the most updated content is available because many users will simply access a past version created by the '700 patents because they will not want the bother of selecting updates, all the while not realizing that the information is out of date.

Also, the ' 700 patent reference (column 8, line 17-31) refers to the URL container and how when it is modified with an additional URL the "new page is then added to the flattened page file." The 700' Patent's system does not re-retrieve the previously retrieved URLs and only retrieves the most recent web page for the newly added URL. Therefore both citations to the '700 patent fail to teach the concepts claimed by the Applicants' claim 29.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 8-12 and 27-31 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 8-12 and 27-31.

Respectfully submitted,

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CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

8. A method suitable for use with a printing system for dynamically linking changing content present in a page in a network with a document, said method comprising the steps of:

inserting a link into the document, said link corresponding to a page present in the network wherein the page includes a web page,

automatically launching a browser in response to the link,

automatically retrieving the content of the page from the network, and

automatically converting the content of the page into an image file suitable for insertion into the document, and

automatically inserting the converted content into the document.

9. The method of claim 8, wherein the step of inserting a link comprises the step of inserting a uniform resource locator (URL) into the document, and wherein the step of launching comprises the step of launching a web browser, wherein the URL corresponds to a web page in the network.

10. The method of claim 8, wherein the step of inserting comprises the step of directly inserting the converted content into the document such that when the document is accessed the converted content is displayed as a readable part of the document.

11. The method of claim 8, wherein the page includes a web page and the browser includes a web browser, further comprising the step of automatically, dynamically inserting the link into the document to dynamically retrieve content associated with the web page for subsequent incorporation into the document.

12. The method of claim 8, further comprising the step of repeating the steps of launching, retrieving, converting and inserting as a function of the number of links inserted into the document.

27. The method of claim 8 wherein the content of the page is inserted into the document such that when the document is printed into a hardcopy format the content of the page is printed into the hardcopy format as part of the document.

28. A printing system for automatically and dynamically linking content from an existing network page into a document generated using a document creation algorithm, the system comprising:

a document creation algorithm for creating, retrieving or assembling a document;

a link facility for manually creating and inserting a network link into the document wherein the link is associated with an existing network page;

a browser for automatically accessing and retrieving the content of the network page associated with the link; and

a production agent for automatically converting the content of the network page into an image file and for automatically inserting the content into the document.

29. The printing system of claim 27 wherein upon subsequent access of the document, the browser launches automatically accessing and retrieving the most recently updated content of the network page without need for action or knowledge of a user.

30. The printing system of claim 28 wherein upon subsequent access of the document, the production agent automatically converts the content of the network page into the image file and inserts the content of the network page into the document without need for action or knowledge of said user.

31. The printing system of claim 29 wherein the document and the inserted content of the network page are readily available in a readable format for display on a user interface or for printing.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE